

REMARKS

Applicants have carefully considered the January 31, 2006 Office Action, and the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance.

Claims 1-29 are pending in this application. Claims 7-14, 16-25, 28 and 29 have been allowed. Claims 1-6, 15, 26 and 27 have been rejected. Entry of the present Request for Reconsideration is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-6, 15, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McCay (U.S. Pat. No. 6,283,276, hereinafter "McCay") in view of Laxo (U.S. Pat. No. 2,455,127, hereinafter "Laxo"). Applicants respectfully traverse.

The Examiner asserted that McCay discloses the envelope insert conveyor assembly of claim 1, but for a gripping element disposed adjacent to an indented portion. The Examiner asserted that Laxo discloses gripping element 33 disposed adjacent an indented portion 29. The Examiner concluded that it would have been obvious to include such a gripping element onto McCay's holder 40 because it would allegedly "keep the conveyed articles sliding off to the side."

In response to Applicants' Amendment previously submitted on December 2, 2005, the Examiner maintained the rejection and asserted that it would have been obvious to include a gripper on McCay's conveyor since McCay's holders 40 are similar to the holder taught by Laxo. Applicants respectfully traverse the rejection and submit that independent claims 1 and 26, as well as their respective dependent claims (2-6, 15 and 27) are patentably distinct over the cited patents.

Independent claim 1 describes, in pertinent part, an envelope insert conveyor assembly that comprises a gripping element disposed adjacent an indented portion of one of the paired

sidewalls and biased toward an interior surface of the indented portion. Independent claim 26 describes, *inter alia*, a pusher member for conveying an envelope insert, wherein one of the generally U-shaped indented portions comprises a gripping element having a gripping member which is resiliently biased toward an interior surface of the indented portion.

McCay, which is discussed in the background section of the present application at pages 1-3, discloses a plurality of pusher elements 40 are attached to conveyor chains 30 at a fixed spaced-apart distance. Each pusher element has a lower portion 40a for supporting the bottom of a sheet(s) and an indented portion 40b for receiving the rear portion of sheet(s) and pushing the same in paper feed direction F. McCay provides a guide 100 to control the degrees of freedom of movement allowed of pusher 40 and for assuring that pusher element 40 moves only in the X direction with no deflection in the Y or -Z directions. Guide 100 comprises a guiding element 50 of a selected cross-sectional shape (e.g., a circular cross-section). Sidewalls 42 of the pushers 40 are configured to straddle the respective guiding element 50. Thus, McCay is silent as to any gripping element disposed near indented portion 40b. Rather, McCay desires to control the degree of freedom of movement allowed for pusher 40 to control sheet skew and, therefore, does not disclose or remotely suggest a pusher finger guide that reduces the opportunity for sheet skew, as disclosed in the present specification.

Laxo is directed to a conveyor gripper member for can bodies and the like. In contrast, McCay is directed to an apparatus for handling sheets and, therefore, the references are completely unrelated in terms of the type of material their respective gripping members engage and advance. Indeed, Laxo, at col. 1, lines 28-33, provides a conveyor gripping member for propelling a can body along a path and prevents the turning of the can body about its axis by insuring a positive locking of the can to the conveyor.

Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the present claimed subject matter under 35 U.S.C. § 103 in view of the lack of the requisite realistic motivation. In the present case, Applicants submit that the Examiner's statement to modify McCay in view of Laxo lacks the requisite realistic motivation. The references are completely unrelated in terms of the type of material their respective gripping members engage and advance. The Examiner merely states that the since the holders taught by both patents are "similar", it would have been obvious for one of ordinary skill in the art to combine the references to produce the claimed subject matter. It is respectfully submitted that the Examiner's proposed modification amounts to nothing more than the judicially condemned "obvious to try" standard. *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

The Examiner has failed to explain how Laxo's gripping element which is designed to grip a circular can body and prevent its turning would be modified to accommodate the sheets in McCay's sheet handling apparatus which is designed to prevent paper sheet skewing. Laxo's apparatus has nothing to do with sheet handling and is not remotely relevant to the particular problem addressed by McCay, namely paper sheet skewing. Accordingly, it is not apparent and the Examiner has not explained why one having ordinary skill in the art would have been realistically impelled to modify McCay's sheet handling apparatus with Laxo's gripping element designed to clasp a can body.

Moreover, Applicants submit that the Examiner's asserted motivation to modify McCay in view of Laxo is not found in either McCay or Laxo. Instead, the Examiner improperly relies on the benefit of hindsight using Applicants' own disclosure. Applicants' own disclosure, however, is forbidden territory for the Examiner to obtain the requisite motivation for combining

the applied prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985). Accordingly, for the reasons set forth above, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed subject matter under 35 U.S.C. § 103 for lack of the requisite factual basis and lack of the requisite realistic motivation. Thus, the rejection should be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter. Claims 7-14, 16-25, 28 and 29 were allowed.

It is believed that pending claims 1-29 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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